



UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE
United States Patent and Trademark Office
Address: COMMISSIONER FOR PATENTS
P.O. Box 1450
Alexandria, Virginia 22313-1450
www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/809,494	03/15/2001	Alexandra Keene	P/2167-230	5659

7590 11/02/2004

STEVEN I. WEISBURD, ESQ.
DICKSTEIN SHAPIRO MORIN & OSHINSKY LLP
1177 AVENUE OF THE AMERICAS
41ST FLOOR
NEW YORK, NY 10036-2714

EXAMINER

WEISBERGER, RICHARD C

ART UNIT PAPER NUMBER

3624

DATE MAILED: 11/02/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

DETAILED ACTION

The criteria stated in 37 CFR 1.105 for making a requirement for information is that the information be reasonably necessary to the examination or treatment of a matter in an application. The information required would typically be that necessary for finding prior art or for resolving an issue arising from the results of the search for art or from analysis of the application file. A requirement for information necessary for finding prior art is not a substitute for the examiner performing a search of the relevant prior art; the examiner must make a search of the art according to MPEP § 704.01 and §§ 904 – 904.03.

The criteria of reasonable necessity is generally met, e.g., where:

- (A) the examiner's search and preliminary analysis demonstrates that the claimed subject matter cannot be adequately searched by class or keyword among patents and typical sources of non-patent literature, or
- (B) either the application file or the lack of relevant prior art found in the examiner's search justifies asking the applicant if he or she has information that would be relevant to the patentability determination.

The first instance generally occurs where the invention as a whole is in a new area of technology which has no patent classification or has a class with few pieces of art that diverge substantially from the nature of the claimed subject

matter. In this situation, the applicant is likely to be among the most knowledgeable in the art, as evidenced by the scarcity of art, and requiring the applicant's information of areas of search is justified by the need for the applicant's expertise.

The second instance generally occurs where the application file, or other related applications or publications authored by the applicant, suggests the applicant likely has access to information necessary to a more complete understanding of the invention. In this situation, the record suggests that the details of such information may be relevant to the issue of patentability, and thus shows the need for information in addition to that already submitted by the applicant.

Here the application file suggests that the applicant has access to information necessary for an understanding of the invention (specification, page 2, line 3+)

Here it is appropriate to make a requirement for information prior to the first action on the merits, such as with a restriction requirement, when the examiner's search and preliminary analysis demonstrates that the claimed subject matter cannot be adequately searched by class or keyword among patents or in areas of emerging technology where the Office has minimal prior art.

Factors considered for the appropriateness of a separate requirement for

information prior to the first action on the merits included;

(A) the claimed subject matter is in a newly established art area without a well-developed prior art resource pool;

(B) The related documents, written by an inventor or an employee of the assignee, which were not submitted, are found during the search or described in the application file (specification, page 3, line 5)

(C) The non-patent literature is referred to in the disclosure, but a copy has not been supplied (specification, page 3, line 5)

In response to this requirement, please state the names of systems and/or the names of companies providing the CD-ROM notification system and/or the proprietary dial-in online access notification system and/or and the FAX notification systems referenced as prior art in applicant's specification.


In responding to those requirements that require copies of documents, where the document is a bound text or a single article over 50 pages, the requirement may be met by providing copies of those pages that provide the particular subject matter indicated in the requirement, or where such subject matter is not indicated, the subject matter found in applicant's disclosure.

The fee and certification requirements of 37 CFR 1.97 are waived for those documents submitted in reply to this requirement. This waiver extends

only to those documents within the scope of this requirement under 37 CFR 1.105 that are included in the applicant's first complete communication responding to this requirement. Any supplemental replies subsequent to the first communication responding to this requirement and any information disclosures beyond the scope of this requirement under 37 CFR 1.105 are subject to the fee and certification requirements of 37 CFR 1.97.

The applicant is reminded that the reply to this requirement must be made with candor and good faith under 37 CFR 1.56. Where the applicant does not have or cannot readily obtain an item of required information, a statement that the item is unknown or cannot be readily obtained will be accepted as a complete reply to the requirement for that item.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Richard C Weisberger whose telephone number is 703 308 4408 and whose email is Richard.weisberger@uspto.gov.



Richard C Weisberger
Primary Examiner
Art Unit 3624

Vince Millin
SPE AU 3624